

**This Page is Inserted by IFW Indexing and Scanning  
Operations and is not part of the Official Record**

**BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKewed/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** \_\_\_\_\_

**IMAGES ARE BEST AVAILABLE COPY.**

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,713	11/29/2001	Glen Friedman	ISURFTV149	4318

33448 7590 09/01/2004

ROBERT J. DEPKE LEWIS T. STEADMAN  
HOLLAND & KNIGHT LLC  
131 SOUTH DEARBORN  
30TH FLOOR  
CHICAGO, IL 60603

EXAMINER

BAYERL, RAYMOND J

ART UNIT	PAPER NUMBER
----------	--------------

2173

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/997,713	FRIEDMAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Raymond J. Bayerl	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1</u> . | 6) <input type="checkbox"/> Other:  |

Art Unit: 2173

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 200, fig 2 (paragraph [0025]); 240, fig 2 (paragraph [0028]); 310, fig 3 (paragraph [0032]). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 – 5, 8 – 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Gupta et al. (“Gupta”; US #6,546,405 B2).

As per independent claim 1’s “method” in which an “annotation file” is created for “a multimedia presentation”, Gupta’s ANNOTATING TEMPORALLY-DIMENSIONED MULTIMEDIA CONTENT is achieved when A human viewing temporally-dimensioned content will annotate, comment upon, and augment the multimedia document (Abstract). Thus, “specifying at least one desired portion” occurs (see also col 2, lines 13 – 35). The resulting annotation entry 300 <sup>PS</sup> records “at least one pointer corresponding to the at least one desired portion” (col 10, line 65 – col 11, line 35), in an annotation collection 420 (the claimed “annotation file”; see also figs 3, 4).

As per claim 2's "creating" and "playing the recorded program file" (see also claim 9), this is the function of Gupta's multimedia document player (col 2, lines 36 – 48). Since a Gupta user can select a temporal annotation from a list, at which point the multimedia document player immediately proceeds to the presentation of the multimedia document at the particular relative time (col 2, lines 48 – 64), Gupta further discloses "accessing the annotation file such that only the at least one desired portion...is displayed".

The application of "a predetermined set of criteria" in "specifying at least one desired portion" (claims 3, 10, 14) reads upon Gupta's identical teaching that The user can select temporal annotations which satisfy various criteria for inclusion in the display of the multimedia document (col 2, lines 48 – 54), these being "based upon a preference of an individual viewer" (claims 4, 11, 15), such as a particular date.

Claim 5's "annotation file" that "further contains: information related to the at least one desired portion" (see also claims 12, 16) reads upon the inclusion of user authored content in content field 310 of a Gupta temporal annotation entry 300 (col 4, lines 52 – 63).

Independent claim 8 is similar to claim 2 as treated above, and is anticipated by Gupta, who teaches "creating an annotation file" in collection 420, and "accessing the annotation file" to render "at least one desired portion" by the multimedia document player according to various criteria for inclusion.

Independent claim 13's use of "a recorded program file" reads upon Gupta's storage of the original Multimedia document 140, which can alternatively be a motion

Art Unit: 2173

video or audio file (col 4, lines 28 – 51). In handling the collection 420, Gupta uses “an annotation management software” so that “a display device displays the at least one desired portion”, as noted above with respect to Gupta’s multimedia document player.

The overall collection 420 in Gupta’s annotation database will have “information related to a portion...other than the at least one desired portion” (claim 17), since annotations to portions other than those satisfying criteria are included.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 6 – 7, 18 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Kelly et al. (“Kelly”; US #5,907,322 A).

As per independent claim 6’s “broadcasting an event” and “specifying at least one desired portion of the event”, Gupta does not contain **explicit** teachings of such a

Art Unit: 2173

mode of transmission, being more concerned with what happens at the site of the multimedia document player itself. However, Kelly's TELEVISION EVENT MARKING SYSTEM allows for bookmarking viewer selected TV broadcast events (Abstract), and storing a set of event-identifier data associated with the set of selected broadcast events (see also col 1, lines 54 – 67).

Thus, it would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to use the "annotation file" of Gupta, in which the annotation database is made available to a broadcast receiver as per Kelly, with the motivation being Gupta's own disclosure of A public temporal annotation (Gupta, col 3, lines 4 – 16)—the Kelly viewer would then have the benefit of the additionally-authored bookmarks at the site of reception.

The Kelly bookmarking follows the selected broadcast event, and thus, any "annotation file" created as per Gupta will be "transmitted subsequent to the event" (claim 7).

Independent claim 18's use of "an editor to create an annotation file" reads upon the Gupta author's creation of entries in the collection 420. The use of "a first" and "second transmission medium" for the "presentation" and the "annotation file" is suggested by an extension to Kelly's broadcast environment, when receiving the additional Gupta annotations.

Claims 19, 20 are rejected using a line of reasoning similar to that presented for respective claims 3, 5 above.

Art Unit: 2173


7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The additional US Patent documents made of record (see attached form PTO-892) relate to the creation of additional, annotating data for various forms of media content.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Bayerl whose telephone number is (703) 305-9789. The examiner can normally be reached on M - F from 10:00 AM to 5:00 PM.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (703) 308-3116. All patent application related correspondence transmitted by FAX **must be directed** to the central FAX number (703) 872-9306.

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



RAYMOND J. BAYERL  
PRIMARY EXAMINER  
ART UNIT 2173

30 August 2004